

REMARKS

After entry of this Amendment, claims 3-5, 7 and 19-38 remain pending in the subject application. Specifically, claims 3-5, 7, and 19-30 remain unchanged, claims 1, 2, 6, and 8-18 were previously canceled, and new claims 31-38 have been added. As described below, full support for these new claims can be found in the original specification of the subject application. Therefore, no new matter has been added in this Amendment.

New Claims and Comments

New claims 31-38 have been added to further focus on certain embodiments of the present invention. Support for these amendments can be found in at least paragraphs [0047]-[0056] of the original specification, as published. No new matter has been added in this Amendment.

Claim Rejections - Under 35 U.S.C. §103(a)

Claims 3-5, 7, 19, 25, 27 and 29 stand rejected under 35 U.S.C. §103(a) as being obvious over Colas et al., EP 0955347 (Colas), in view of Johnson et al., U.S. Pat. No. 6,475,329 (“Johnson”). In addition, claims 20-24, 26, 28 and 30 stand rejected under 35 U.S.C. §103(a) as being obvious over Colas in view of Johnson. The Applicants respectfully traverse these rejections as described in detail below.

The Applicants respectfully assert that the Examiner has failed to establish a motivation to combine the teachings of Colas and Johnson to arrive at the present invention as is claimed in the subject application. One of ordinary skill in the art **would not** look to the teachings of

Johnson in light of the teachings of Colas (or vice versa), as the Examiner contends, because neither of the prior art references provide an adequate teaching, suggestion or motivation to do so.

One skilled in the art would **not** choose to modify the method of Colas to include an additional step of applying a primer to a substrate or to a crosslinked silicone gel prior to bonding the substrate to the crosslinked silicone gel (or vice versa). In addition, the teachings of Johnson fail to remedy the deficiency of Colas lacking a teaching of applying a primer because Johnson only teaches applying uncrosslinked silicone gel compositions to primers and actually **teaches away** from the use of applying crosslinked silicone gel compositions due to adhesion issues (see column 5, lines 28-31 of Johnson).

Because Johnson teaches away from combining a primer with silicone gel composition **after the silicone gel composition has cured**, one of ordinary skill in the art would not modify Colas to incorporate certain features of Johnson in an effort to arrive at the present invention, as claimed. Accordingly, the Applicants respectfully submit that the obviousness rejections are improper and respectfully request that the obviousness rejections be withdrawn. If the Examiner remains unconvinced with these arguments, the Applicants respectfully direct the Examiner to the supplemental arguments below, which further reinforce the Applicants' position with respect to nonobviousness of the present invention.

As a preliminary matter, the Applicants incorporate their prior arguments on pages 2 and 3 of the Response dated January 15, 2010, where the Applicants clearly distinguished

the present invention from the disclosures of Colas and Johnson.¹ In relevant part, Colas does not teach or suggest use of a primer at all, let alone a specific primer, for adhering a silicone gel to a substrate. The Applicants appreciate that Colas briefly teaches the use additives for improving adhesion (paragraph [0019]), but such additives are “included in the gels”, such that there is no way that such additives could be equated to be used for “treating” a surface of the gels and/or any other substrate for that matter. Those skilled in the art readily appreciate that such additives are typically dispersed throughout the gel and are not used as separate components based on a variety of reasons, e.g. cost. In addition, Colas fails to provide even a single example of what type or types of adhesion promoters should be used, how much should be used, etc.

On the other hand, Johnson teaches use of a primer for increasing adhesion of certain compositions to substrates, but only in the context of using a specific primer in a specific method. Specifically, in its method, Johnson teaches steps of:

coating a polymer surface with its primer;

applying an uncrosslinked silicone composition, i.e., a silicone gel precursor, to the polymer surface; and

crosslinking the silicone composition to form an adhesive bond between the (now crosslinked) silicone composition and the polymer surface (see, e.g., column 2, lines 16-54; and column 5, lines 24-26 and 47-48 of Johnson).

¹ This strategy of incorporating select prior arguments does not mean that the Applicants concede any other prior arguments not discussed herein.

Said another way, Johnson teaches applying silicone gel precursors to the polymer surface, and does not teach or even suggest the application of silicone gel compositions that have already been crosslinked, i.e., cured into a silicone gel. As such, even if for argument's sake, one were to combine the teachings (or even suggestions) of Colas and Johnson in the manner the Examiner is contending, one would still not arrive at the present invention, as claimed.

On page 2 of the instant Office Action, the Examiner contends that the "Applicant argues... Johnson et al. do(es) not teach or suggest applying primer to a silicone composition". However, the Applicants respectfully assert that this is not the case. In the Response dated January 15, 2010, the Applicants stated that:

Johnson et al. does not teach or suggest applying primer on the uncrosslinked silicone composition. Further, Johnson et al. does not teach or suggest applying a silicone gel to the primer polymer surface or applying primer on the silicone gel before applying to a polymer surface. In fact, Johnson et al. teaches away from this... (emphasis in original and emphasis added).

As such, it is clear that the Applicants contended (and still contend), rightfully so, that a major distinction between the teachings and suggestions of Johnson and the claimed invention is that Johnson relies on the use of a uncrosslinked silicone gel compositions, and more importantly, teaches away from the use of crosslinked silicone gel compositions (see column 5, lines 28-31 of Johnson), as already described in detail above.

As the Examiner is well aware, "[o]ffice personnel should consider all rebuttal arguments and evidence presented by applicants."² In the instant Office Action, the Applicants

² MPEP §2145 referencing *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687.

respectfully assert that the Examiner has failed to do so in her mischaracterization of the Applicant's position illustrated above. Specifically, the Examiner should have at least considered the Applicant's "teaching away" arguments due to the sheer importance of such arguments when combating allegations of obviousness. Specifically, "[a] prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness..."³ More importantly, "[i]t is improper to combine references where the references teach away from their combination."⁴

The Applicants appreciate the Examiner's reliance on *New Wrinkle*⁵ on pages 2, 4 and 6 of the instant Office Action when attempting to establish the instant obviousness rejections. However, the Applicants respectfully caution the Examiner in relying on *New Wrinkle*. Specifically, *New Wrinkle* was decided in March of 1953⁶, which is 13 years before the "proper" test for obviousness was set forth in *Graham*⁷, and more than 50 years before the *Graham* factors were reaffirmed by *KSR*⁸.

In addition, the holding in *New Wrinkle* with respect to "obviousness" is very fact specific, where in the alleged invention in *New Wrinkle*, unreactive ingredients of a coating composition were merely added simultaneously relative to previously being added sequentially in the prior art to form the coating composition. In contrast, the present invention involves much more than merely mixing unreactive ingredients or applying them

³ MPEP §2145, emphasis added.

⁴ *Id.* citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983), emphasis added.

⁵ *New Wrinkle v. Watson*, 206 F.2d 421, 96 USPQ 436 (1953).

⁶ This is not to say that "old" law is never good law, but law necessarily evolves over time based on subsequent decisions.

⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966).

⁸ *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007).

in a different order as the Examiner seems to infer. The Examiner can surely appreciate that components that cure, and the intricate curing mechanisms thereof, greatly impact final properties of compositions and products that employ the same. For example, applying an uncured/"wet" adhesive to a substrate relative to applying a cured/"dry" adhesive to a substrate will have starkly different adhesion properties, i.e., a cured adhesive will generally have no adhesion to the substrate.

To be sure, the Examiner outlines the *Graham* factors on page 3 of the instant Office Action. However, as the Examiner is aware, MPEP §2143 states that "[t]he key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit" (emphasis added).

As the Examiner is aware, for each of the *KSR* rationales listed in the MPEP⁹, if any of the respective findings cannot be made, then the rationale cannot be used to support a conclusion that a claim would have been obvious to one of ordinary skill in the art. In addition, it is clear that for each of the *KSR* rationales, regardless of the rationale(s) relied upon, the Examiner must articulate each and every one of the findings.

The Applicants appreciate that the *KSR* rationales are not an all-inclusive list; however, the MPEP requires that some rationale be provided in order to support a conclusion of obviousness. In this case, the Applicants respectfully assert that not only has the Examiner

⁹ MPEP §2143.

failed to properly establish one or more of the *KSR* rationales, e.g. rationale (G)¹⁰, the Examiner has failed to present any type of rationale whatsoever.

In particular, the instant obviousness “rejections” lack a clear articulation of the reasons why the claimed features of the present invention would allegedly have been obvious and, therefore, the rejections cannot be supported per the requirements set forth by the United States Supreme Court in the *KSR* decision. If anything, in the instant Office Action, the Examiner has merely opined on what one skilled in art would gather from the teachings of the Colas and Johnson. Thus, it is respectfully submitted that these rejections are improper and must be withdrawn.

Conclusions

In view of the arguments detailed above, the Applicants respectfully submit that independent claims 19 and 20 are both novel and non-obvious, in view of the disclosure, teachings, and suggestions of the prior art, either independently or combined, such that independent claims 19 and 20, as well as the claims that depend therefrom, are in condition for allowance.

¹⁰ Also known as the teaching, suggestion or motivation (TSM) test.

If any additional fees are necessary to respond to the outstanding Office Action, you are hereby authorized to charge such fees to Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys PLLC.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

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